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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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36084	7590	05/07/2008		
DONN K. HARMS PATENT & TRADEMARK LAW CENTER SUITE 100 12702 VIA CORTINA DEL MAR, CA 92014			EXAMINER MI, QIUWEN	
			ART UNIT 1655	PAPER NUMBER
			MAIL DATE 05/07/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/571,749

Applicant(s)

EWE, CHOR EE

Examiner

QIUWEN MI

Art Unit

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-8 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 13 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Claims Pending

Claims 1-8 are pending. Claims 1-8 are examined on the merits.

Claim Objections

Claims 1-7 are objected to because of the following informalities: Claims 1-7 recite “a herbal applicator”, which is incorrect. The correct recitation should be “an herbal applicator”. Claims 1 (line 6), claim 3 (lines 3), and claim 8 (line 6) are objected for reciting “the said ”, as the simultaneous use of “the” and “said” is redundant.

Appropriate correction is required.

Claim Rejections –35 USC § 112, 2nd

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 2, 7, and 8 recite improper “a herbal applicator...comprising of a flexible **main housing**”, and it is not clear what Applicant means by “main housing”. In addition, claims 1 and 8 recite “...to reduce the vapourizing temperature to a **curie temperature**”, and it is uncertain what a “curie temperature” stands for.

Claims 1 and 8 have no antecedent basis for the limitation, "the vapourized herbal essence" in line 11, and "the vapourizing temperature" in line 13; Claim 3 has no antecedent basis for the limitation "the contours of the body" in line 3.

Claim 4 contains the trademark/trade name "Velcro". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. Applicant is required to provide full generic names of the material that is used in the claims since "Velcro" does not tell one of ordinary skills in the art exactly what is in the material and such trademark can change the material at any time.

Therefore, the metes and bounds of claims are rendered vague and indefinite. The lack of clarity renders the claims very confusing and ambiguous since the resulting claims do not clearly set forth the metes and bounds of the patent protection desired.

All other cited claims depend directly or indirectly from rejected claims and are, therefore, also, rejected under U.S.C. 112, second paragraph for the reasons set forth above.

Claim Rejections –35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, and 6-8 are rejected under 35 USC § 102 (e) as being anticipated by Church et al (US 6,572,871).

Church et al teach a heating wrap for placement against an injured/painful area of a person's body (thus applied directly on to the skin of the body) and an analgesic cream being placed between the heating wrap and the injured/painful area. Church et al further teach that the preferred list of ingredients for analgesic cream comprising aloe vera gel, garden balsam leaf extracts, coconut waxes, jasmine essence, willow extract, echinacea, horsechestnut extract etc (col 3, lines 60-68; col 4, lines 1-10) (thus herbal applicator). The added heat from the heating wrap enhances the permeability of the skin and tendency of the cream to permeate into the skin. The heat wrap may be a pad that includes a flexible sleeve (flexible main housing) for receiving and surrounding the pad, plus a set of straps for holding the pad or pad/sleeve combination on the body area that is to be treated (thus easily adapts to the contours of the body) (thus affixed with an attachment means and a corresponding attachment means is affixed on to the herbal pad

retainer, the said attachment means is to facilitate easy removal and attaching of the herbal pad). The preferred heating wrap includes a thin sheet (top member) that will absorb water, which sheet may be dampened with water (thus prevent the heat generated from the heater pad from being dispersed to the outside) and inserted between the heating pad (bottom member) (thus made up of two sections, and allow easy removal of the herbal pack for replenishment) (thus contain the heat generated by the heater pad within to heat the herbs effectively) and surrounding flexible sleeve (heater pad retainer), for providing moist heat treatment (see Abstract). Church et al also teach that the preferred heating means is an electrical heating pad that is thermostatically-controlled (thus adjustable temperature controlled, for regulating the required temperature of the heater pad in order for it to vapourize the herbs contained in the herbal pack) (col 1, lines 50-55). At last, Church et al teach that the addition of heat causes a deep-heating of the body tissue, without over-heating the skin, which increases the skin's permeability to the cream, and consequently increased deep-penetration of the herbal, analgesic, antiinflammatory, and other ingredients of the cream (col 3, lines 7-15) (thus when the herbs inside the herbal pack are heated, until they vaporize, the herbal pack retainer then will allow the vaporized herbal essence to permeate through it and onto the skin and at the same time absorb part of the heat the helps to reduce the vapourizing temperature to the curie temperature).

Therefore, the reference is deemed to anticipate the instant claim above.

Claims 1-8 are rejected under 35 USC § 102 (e) as being anticipated by Smith, III et al (US 2003/0069618).

Smith, III et al teach a method comprising heating the selected area to a sustained skin temperature, using a device comprising a heat source capable of conductively heating the selected area. The method also comprises administering simultaneously a topical composition containing an active agent (see Abstract), such as flavonoid compounds obtained as extracts from natural sources (e.g. plants) [0067] (thus an herbal applicator). Smith, III et al also teach that the term “wearable device”, which includes the term “sleeve”, means a substantially flexible section of material in the form of, for example, a wrap, patch, cuff or a bandage which may be placed on/confirm to which may be held adjacent, selected area of the body (thus a flexible main housing which can be easily attached on to the body). Such as a wrap, patch, cuff or bandage may be formed from a substrate, preferably a disposable substrate (thus allow easy removal of the herbal pack for replenishment). The sleeve may, in addition, be dimensioned and adapted to apply compression. The sleeve in the form of a wrap, patch, cuff or bandage may be held in place by the use of straps or fasteners. For example, one side of the sleeve may be connected to the other side of the sleeve, using buttons, Velcro or the like [0055]. Smith, III et al further teach that the device can be either actively AC or DC powered (electrical, battery, etc) [0092]. Smith, III et al teach that a heating pad is prepared. Coated thermal resistance wire is sewn to a semi-rigid nylon (thus made up of two sections). Excess mesh is folder over the wire and both sides of the wire and mesh are wrapped with, and sewn to, a polyester nonwoven batting (heater pad retainer). The end of the resistance wire is connected through bimetallic thermal safety switches to an A.C. power source at 120 volts. A controller integral to the power cord includes a phase fired switch to create a user-adjustable temperature control (thus affixed with a flexible heater pad that connects to an electrical power source to be regulated by an adjustable temperature

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controller) (thus when the herbs inside the herbal pack are heated, until they vaporize, the herbal pack retainer then will allow the vapourized herbal essence to permeate through it and onto the skin and at the same time absorb part of the heat and helps to reduce the vapourizing temperature to a curie temperature). The entire assembly is wrapped and sealed in waterproof vinyl. A covering of soft polyester is wrapped over the vinyl, and two Velcro straps are sewn to the covering [0100]. Smith, III et al further teach that four additional layers of the same substrate, which is thermally insulating, are placed contiguous to the first substrate on the side away from the wires, and sewn together, to provide insulation against heat loss from one side of the pad (thus prevent the heat generated from the heater pad from being dispersed to the outside) but no insulation on the skin in contact side. This arrangement is particularly beneficial in enabling low power and in facilitating therefore, the use of batteries (portable battery) as a power source.

Claim Rejections –35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Church et al (US 6,572,871) in view of Smith, III et al (US 2003/0069618).

Church et al teach a heating wrap for placement against an injured/painful area of a person's body (thus applied directly on to the skin of the body) and an analgesic cream being placed between the heating wrap and the injured/painful area. Church et al further teach that the preferred list of ingredients for analgesic cream comprising aloe vera gel, garden balsam leaf extracts, coconut waxes, jasmine essence, willow extract, echinacea, horsechestnut extract etc (col 3, lines 60-68; col 4, lines 1-10) (thus an herbal applicator). The added heat from the heating wrap enhances the permeability of the skin and tendency of the cream to permeate into the skin. The heat wrap may be a pad that includes a flexible sleeve (flexible main housing) for receiving and surrounding the pad, plus a set of straps for holding the pad or pad/sleeve combination on the body area that is to be treated (thus easily adapts to the contours of the body) (thus affixed with an attachment means and a corresponding attachment means is affixed on to the herbal pad retainer, the said attachment means is to facilitate easy removal and attaching of the herbal pad). The preferred heating wrap includes a thin sheet (top member) that will absorb water, which sheet may be dampened with water (thus prevent the heat generated from the heater pad from being dispersed to the outside) and inserted between the heating pad (bottom member) (thus made up of two sections, and allow easy removal of the herbal pack for replenishment) (thus contain the heat generated by the heater pad within to heat the herbs effectively) and surrounding flexible sleeve (heater pad retainer), for providing moist heat treatment (see Abstract). Church et al also teach that the preferred heating means is an electrical heating pad that is thermostatically-controlled (thus adjustable temperature controlled, for regulating the required temperature of the heater pad in order for it to vapourize the herbs contained in the herbal pack) (col 1, lines 50-55). At last, Church et al teach that the addition of heat causes a deep-heating of the body tissue,

without over-heating the skin, which increases the skin's permeability to the cream, and consequently increased deep-penetration of the herbal, analgesic, antiinflammatory, and other ingredients of the cream (col 3, lines 7-15) (thus when the herbs inside the herbal pack are heated, until they vaporize, the herbal pack retainer then will allow the vaporized herbal essence to permeate through it and onto the skin and at the same time absorb part of the heat the helps to reduce the vapourizing temperature to the curie temperature).

Church et al do not teach Velcro tape or portable battery.

Smith, III et al teach a method comprising heating the selected area to a sustained skin temperature, using a device comprising a heat source capable of conductively heating the selected area. The method also comprises administering simultaneously a topical composition containing an active agent (see Abstract), such as flavonoid compounds obtained as extracts from natural sources (e.g. plants) [0067] (thus an herbal applicator). Smith, III et al also teach that the term "wearable device", which includes the term "sleeve", means a substantially flexible section of material in the form of, for example, a wrap, patch, cuff or a bandage which may be placed on/confirm to which may be held adjacent, selected area of the body (thus a flexible main housing which can be easily attached on to the body). Such as a wrap, patch, cuff or bandage may be formed from a substrate, preferably a disposable substrate (thus allow easy removal of the herbal pack for replenishment). The sleeve may, in addition, be dimensioned and adapted to apply compression. The sleeve in the form of a wrap, patch, cuff or bandage may be held in place by the use of straps or fasteners. For example, one side of the sleeve may be connected to the other side of the sleeve, using buttons, Velcro or the like [0055]. Smith, III et al further teach

that the device can be either actively AC or DC powered (electrical, battery, etc) [0092]. Smith, III et al teach that a heating pad is prepared. Coated thermal resistance wire is sewn to a semi-rigid nylon (thus made up of two sections). Excess mesh is folded over the wire and both sides of the wire and mesh are wrapped with, and sewn to, a polyester nonwoven batting (heater pad retainer). The end of the resistance wire is connected through bimetallic thermal safety switches to an A.C. power source at 120 volts. A controller integral to the power cord includes a phase fired switch to create a user-adjustable temperature control (thus affixed with a flexible heater pad that connects to an electrical power source to be regulated by an adjustable temperature controller) (thus when the herbs inside the herbal pack are heated, until they vaporize, the herbal pack retainer then will allow the vaporized herbal essence to permeate through it and onto the skin and at the same time absorb part of the heat and helps to reduce the vaporizing temperature to a curie temperature). The entire assembly is wrapped and sealed in waterproof vinyl. A covering of soft polyester is wrapped over the vinyl, and two Velcro straps are sewn to the covering [0100]. Smith, III et al further teach that four additional layers of the same substrate, which is thermally insulating, are placed contiguous to the first substrate on the side away from the wires, and sewn together, to provide insulation against heat loss from one side of the pad (thus prevent the heat generated from the heater pad from being dispersed to the outside) but no insulation on the skin in contact side. This arrangement is particularly beneficial in enabling low power and in facilitating therefore, the use of batteries (portable battery) as a power source.

It would have been *prima facie* obvious for one of ordinary skill in the art at the time the invention was made to use the Velcro tape and portable battery from Smith, III et al since Smith,

III et al teach the heating device with Velcro tape and portable battery yielded beneficial results in cosmetic treatment of skin conditions such as regional fat deposits, one of ordinary skill in the art would have been motivated to make the modifications.

From the teachings of the references, it is apparent that one of the ordinary skills in the art would have had a reasonable expectation of success in producing the claimed invention.

Thus, the invention as a whole is *prima facie* obvious over the references, especially in the absence of evidence to the contrary.

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Qiuwen Mi whose telephone number is 571-272-5984. The examiner can normally be reached on 8 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Qiuwen Mi

/Michele Flood/
Primary Examiner, Art Unit 1655/Michele Flood/
Primary Examiner, Art Unit 1655